

## **REMARKS**

### ***Amendment of Claims 35 and 36***

Claims 35 and 36 are amended to change “apparatus” to —improvement—for proper antecedent basis.

### ***Claim Rejections - 35 USC § 102***

Claims 1-6, 9-13, 18-25, 28-32, and 39-43 are rejected as being anticipated by US 5,895,628 (Heid et al.). Claims 2 and 21 are cancelled. This rejection is respectfully traversed for reasons presented below.

Amended claim 1 is directed to the improvement comprising “a plurality of processing stations allocated to said loading station, wherein the number of processing stations in said plurality of allocated processing stations is selected by a user and can be varied.” As correctly noted in the Office Action, the apparatus of Heid et al. has an opening (4) that acts as a loading station, however, there are no processing stations (treatment containers 6a-j) allocated to the loading station (4). The specimen holder baskets are inserted into the loading station (4), where they remain until they are respectively taken up by the transport system for deposit into a processing station. See column 3, line 66 – column 4, line 5. So, there are no processing stations allocated to the loading station (4) in Heid et al. For this reason, removal of the rejection as to claims 1, 3-6, 9-13, 18, and 19 is respectfully requested.

Amended claim 20 claims an improvement comprising “a plurality of processing stations allocated to said removal station, wherein the number of processing stations in said plurality of processing stations is selected by a user and can be varied.” The apparatus of Heid et al. includes an opening (5) that acts as a removal station, and specimen holder baskets are “set down in the removal station (5) after the complete staining program has been carried out.” Column 4, lines 5-6. Thus, there are no processing stations allocated to the removal station (5) in Heid et al. For the foregoing reason, removal of the rejection as to claims 20, 22-25, 28-32, 39, and 40 is respectfully requested.

The reasons for rejecting claims 41-43 based on Heid et al. are not specifically discussed in the Office Action, and applicants find no teaching in Heid et al. of the improvements defined by amended claims 41-42 and claim 43. Therefore, applicants kindly request that the rejection of claims 41-43 as anticipated by Heid et al. be withdrawn.

Claims 1-6, 9-13, 18-25, 28-32, and 39-43 are rejected as being anticipated by US 6,635,225 (Thiem et al. ‘225). Claims 2 and 21 are cancelled. This rejection is respectfully considered overcome by amendment of claims 1 and 20 to include the limitations of claims 2 and 21, respectively, as discussed below.

The apparatus of Thiem et al. ‘225 includes two side-by-side processing stations (reagent containers 3 at the far left of the automatic stainer as seen in Fig. 1) that may be

considered as being allocated to a "loading station". However, the number of processing stations allocated to the loading station cannot be varied or selected by the user, as claimed. Therefore, Thiem et al. '225 does not anticipate the present invention as set forth in amended claim 1. Removal of the rejection as to claims 1, 3-6, 9-13, 18, and 19 is respectfully sought.

Thiem et al. '225 describes a removal station 8 having a reagent container 9 at the end of each of the two rows of the automatic stainer, but the number of processing stations (containers 9) in the plurality of processing stations allocated to the removal station cannot be varied or selected by the user, as set forth in amended claim 20. On this basis, applicants respectfully ask that the rejection of claims 20, 22-25, 28-32, 39, and 40 as anticipated by Thiem et al. '225 be withdrawn.

The basis for rejecting claims 41-43 as anticipated by Thiem et al. '225 is not discussed in the Office Action, and applicants find no teaching in this reference of the improvements defined by amended claims 41-42 and claim 43. Therefore, applicants kindly request that the rejection of claims 41-43 as anticipated by Thiem et al. '225 be withdrawn.

Claims 1-6, 9-13, 18-25, 28-32, and 39-43 are rejected as being anticipated by US 6,635,225 (Thiem et al. '365). Claims 2 and 21 are cancelled. This rejection is considered overcome by amendment of claims 1 and 20 to include the limitations of claims 2 and 21, respectively, as discussed below.

The apparatus of Thiem et al. '365 is in the form of a circular array of processing stations (chemical containers 4 and paraffin containers 5). There is no teaching or suggestion in this reference of a loading station, or that any of the processing stations are allocated to a loading station. Because there is no loading station to which processing stations are allocated, it follows that the number of processing stations allocated to a loading station cannot be varied or selected by the user, as claimed. Therefore, Thiem et al. '365 does not anticipate the present invention as set forth in amended claim 1. Removal of the rejection as to claims 1, 3-6, 9-13, 18, and 19 is respectfully sought.

Thiem et al. '365, at Fig. 2, shows two adjacent paraffin stations 5 at which embedding is completed. If these are thought of as a removal station, Claim 20 is nevertheless not anticipated because the number of processing stations (paraffin stations 5) in the plurality of processing stations allocated to the removal station cannot be varied or selected by the user, as set forth in amended claim 20. On this basis, applicants respectfully ask that the rejection of claims 20, 22-25, 28-32, 39, and 40 as anticipated by Thiem et al. '365 be withdrawn.

The basis for rejecting claims 41-43 as anticipated by Thiem et al. '365 is not discussed in the Office Action, and applicants find no teaching in this reference of the improvements defined by amended claims 41-42 and claim 43. Therefore, applicants kindly request that the rejection of claims 41-43 as anticipated by Thiem et al. '365 be withdrawn.

### ***Claim Rejections - 35 USC § 103***

Claims 7-8, 14-15, 26-27, and 33-36 are rejected under 35 USC 103(a) as being unpatentable over Heid et al., Thiem et al. '225, or Thiem et al. '365. The rejection is respectfully overcome in view of amendment of claims 1 and 20 and the remarks made above. Because the references fail to teach or suggest the limitations of the parent claim, they also fail to teach or suggest the limitations of the dependent claims. Favorable reconsideration of Claims 7-8, 14-15, 26-27, and 33-36 is respectfully requested.

Claims 16-17 and 37-38 are rejected under 35 USC 103(a) as being unpatentable over Heid et al., Thiem et al. '225, or Thiem et al. '365 in view of US 5,578,268 (Chapseix et al.). The rejection is respectfully overcome in view of amendment of claims 1 and 20 and the remarks made above. Because the primary references fail to teach or suggest the limitations of the parent claim, they also fail to teach or suggest the limitations of the dependent claims.

Moreover, it is noted that the mobile drawer member 72 of Chapseix et al. is a plate which pushes cassettes out, and does not include any processing stations.

Therefore, it is asked that the rejection of claims 16-17 and 37-38 be removed.

### ***Double Patenting***

Claims 1-43 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over:

- 1) Claims 1-43 of 09/932,900;
- 2) Claims 1-32 of 09/793,199 filed Feb. 26, 2001;
- 3) Claims 1-26 of 10/011,674 .0025; and
- 4) Claims 1-28 of 09/932,889 .0034.

Regarding item (1), 09/932,900 is the present application, so the provisional rejection on that basis should be withdrawn.

Item (2) is pending, and an amendment was mailed on July 27, 2004 amending the claims. Currently, claims 11-12, 17-18, 28-29, and new claims 33-35, are pending. Of these, claim 33 is the only independent claim and reads as follows:

33. An apparatus for staining histological and/or cytological specimens each mounted on a specimen slide, the apparatus comprising:
- a plurality of processing stations arranged in sequence, each of the plurality of processing stations having an excitation coil associated therewith for generating an excitation field;
  - a rack for carrying at least one specimen slide;
  - a **transponder** mounted on the rack for travel with the rack, the transponder having a code associated therewith;

a transport system for automatically transporting the rack and transponder to and from individual processing stations in the plurality of processing stations; and

a **control unit** connected to each of the excitation coils and to the transport system, the control unit executing a processing program to provide commands to the transport system to move the rack and the at least one specimen slide to and from specified processing stations;

the transponder being activated by the excitation field at a processing station to transmit the code to the control unit, wherein the code is evaluated by the control unit to assign the processing program.

The apparatus of claim 33 comprises a transponder and control unit not found in the present claims 1-43, and it does not include a loading station or a removal station as asserted in the Office Action. No double-patenting issues have been raised in 09/793,199 with respect to the present application.

Item (3) includes pending claims 1-25 (claims 15-26 were renumbered as 14-25 due to a numbering error), of which claims 1 and 16-18 are independent. These claims read as follows:

1. In an apparatus for treating objects, in particular for cytological or histological specimens, having multiple processing stations (2) and a transport device (4) for delivering said objects into and out of said processing stations (2), each of said multiple processing stations (2) comprising a container (3) for receiving liquid reagents, and for immersion of said objects or of a rack (7) carrying a plurality of said objects, the improvement comprising:
  - an **insert** (8) that fits into said container (3), said insert (8) reducing the maximum capacity of said container (3); and
  - said rack (7) being sized for receipt by said reduced maximum capacity of said container (3).
16. An apparatus for reducing the volume of a reagent container (3) for treatment of specimens comprising:
  - an **insert** (8) that fits into said container (3), said insert (8) cooperating with said container (3) to reduce the maximum capacity of said container (3), and said insert (8) defining an opening for receiving a rack (7) by immersion.
17. A method for reducing the volume of a reagent container (3) for treatment of specimens comprising the steps of:
  - (a) **placing an insert** (8) into said containers (3), said insert (8) cooperating with said container (3) to reduce maximum volume of said container (3); and
  - (b) immersing a plurality of said specimens into said reduced volume of said container (3).

18. An apparatus for reducing the volume of a reagent container (3) for treatment of specimens comprising:

an insert (8) that reduces the maximum capacity of said container (3) without preventing a rack (7) from being immersed into said reagent.

The apparatus of claims 1 and 16, and the method of claims 17 and 18, are characterized by an insert not found in claims 1-43 of the present application. Claims 1 and 16-18 do not include or involve a loading station or a removal station as asserted in the Office Action. Application 10/011,674 is being examined by Examiner Jyoti Nagpaul, who did not raise double-patenting with the present application in the first Office Action mailed June 17, 2004.

Item (4) presently includes pending claims 1-28, of which claim 1 is the sole independent claim. It reads as follows:

1. In an apparatus for treating cytological or histological specimens, said apparatus having multiple processing stations and a transport device for delivering said specimens or object holders carrying said specimens into and out of said processing stations, the improvement comprising:

said transport device comprises a robot arm that is movable in three dimensions and provides for arbitrary positioning of the objects.

The improvement of claim 1 is directed to a robot arm of the transport device not found in claims 1-43 of the present application. Claim 1 does not include or involve a loading station or a removal station as asserted in the Office Action. Application 09/932,889 is being examined by Examiner Yelena Gakh, who did not raise double-patenting with the present application in the first Office Action mailed February 27, 2004.

What appears to be the case here is that a single apparatus embodies several patentably distinct inventions. Therefore, while there is some overlap in description between the applications, the claims of the applications are patentably distinct as discussed above.

In view of the foregoing, removal of the provisional double-patenting rejection is respectfully sought.

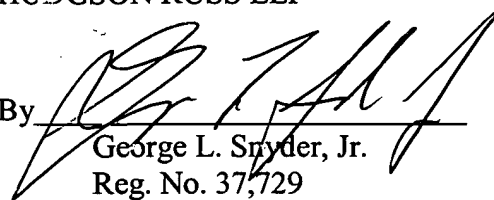
***Conclusion***

The present application is respectfully considered to be in a condition for allowance, and favorable reconsideration is kindly sought. If the Examiner has any questions, the undersigned attorney may be contacted at the number provided below.

Respectfully submitted,

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